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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,917	03/23/2005	Peter R Ebner	MAX 02.01CIP	9044
27667	7590	02/26/2008	EXAMINER	
HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718			WOODALL, NICHOLAS W	
			ART UNIT	PAPER NUMBER
			3733	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,917	Applicant(s) EBNER, PETER R	
	Examiner Nicholas Woodall	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,53,70,86,88,90-100,102 and 104-127 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,53,70,86,88,90-100,102,104-109 and 111-127 is/are rejected.
- 7) ☒ Claim(s) 110 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment received on 11/21/2007.

Allowable Subject Matter

2. The indicated allowability of claims 111 and 127 is withdrawn in view of the newly discovered reference(s) to Terry (U.S. Patent 1,121,053). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 53, 70, 90, 93-95, 97-100, 104-109, 111-113, 115-117, 119-121, and 123-127 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Terry (U.S. Patent 1,121,053).

Regarding claims 1, 53, and 70, Altobelli discloses a device comprising a generally planar blade having a first end and a second end separated by a middle section intermediate the first end and the second end of the blade, wherein the first end includes a cutting edge and an opening capable of allowing bone shavings to pass through and the middle section having at least one outwardly extending lobe, a collection chamber including a bottom, sidewalls, an endwall, and an upstanding retention member (36) capable of securing the at least one lobe of the blade to the collection chamber, and an elongated handle coupled to the end of the collection

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chamber as discussed in the previous office actions. Regarding claims 90 and 112, Altobelli discloses a device wherein the collection chamber comprises a mixing area capable of mixing the bone shavings, blood, and other constituent graft materials.

Regarding claims 97 and 119, Altobelli discloses a device wherein the blade comprising stainless steel. Regarding claims 98-100 and 120, Altobelli discloses a device wherein the blade includes a pair of opposing lobes disposed adjacent a longitudinal slot.

Regarding claim 104, Altobelli discloses a device wherein the second end includes a protrusion capable of being used for extracting the blade from the collection chamber.

Regarding claim 106, Altobelli discloses a device wherein the upstanding retainer mechanism (36) includes a first cam surface, a second cam surface, and a ledge portion, wherein the ledge portion is capable of maintaining at least a portion of the blade in contact with a top surface of the collection chamber. Regarding claim 107, Altobelli discloses a device wherein the ledge portion is spaced from the top surface a distance approximately equal to the thickness of the blade. Regarding claims 108 and 126, Altobelli discloses a device wherein the sidewalls of the collection chamber support the first end of the blade. Regarding claim 109, Altobelli discloses a device wherein the collection chamber further includes a stabilization member (100) capable of restricting rotational movement of the blade. Regarding claim 121, Altobelli discloses a device wherein the blade includes a pair of opposing lobes adjacent a pair of hold-down tabs (36) formed on the collection chamber. Altobelli fails to disclose the blade member being a unitary member, it is noted that the Altobelli device comprises several parts, i.e. the blade and blade cover, which are rigidly secured together as a single unit.

Therefore, the constituent parts are so combined as to constitute a unitary whole or structure. In re Larson, 144 USPQ 347 (CCPA 1965).

Regarding claims 93-95 and 115-117, Altobelli discloses a device wherein the collection chamber is formed from a surgical grade material that is preferably in part transparent. Altobelli fails to disclose the material being stainless steel or a polymer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Altobelli from stainless steel or a polymer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. The examiner believes that it is further obvious to form the part from a surgical grade plastic material since the reference discloses a preferred embodiment wherein the chamber is at least partly transparent.

Further regarding claims 1, 53, 70, 111, 123, 125, and 127, Altobelli fails to disclose a device further comprising a stopping/retaining mechanism. Terry teaches a device comprising two elements including a stopping/retaining mechanism, wherein the stopping/retaining mechanism comprising the second end of a first element includes a pair of cantilevered spring elements (8 and 9) and the second element includes a pin (14), wherein the cantilever spring elements and the pin cooperate together in order to provide a simple and safe form of coupling two elements. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Altobelli further comprising a stopping/retaining mechanism in view of Terry in order to provide a simple and safe form of coupling two elements.

Further regarding claims 111 and 127, the combination of Altobelli and Terry disclose a device wherein the cantilever spring elements form tension cam surfaces capable of engaging the pin.

5. Claims 86, 88, 92, and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Terry (U.S. Patent 1,121,053) further in view of Hutson (U.S. Patent 3,299,511).

Regarding claims 86, 88, 92, and 114, the combination of Altobelli and Terry disclose the invention as claimed except for the elongated handle portion being coupled to the collection chamber through a flexible joint. Hutson teaches an assembly wherein an instrument is connected to a handle by means of a swivel joint in order to allow the operator to readily turn the instrument in any direction (column 1 lines 42-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the combination of Altobelli and Terry with a swivel joint between the handle and the collection chamber in view of Hutson in order to allow the operator to readily turn the instrument in any direction.

6. Claims 86, 88, 91, 92, 96, 113, 114, and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Terry (U.S. Patent 1,121,053) further in view of Castaneda (U.S. Publication 2003/0074014).

Regarding claims 86, 88, 92, and 114, the combination of Altobelli and Terry disclose the invention as claimed except for the elongated handle portion being coupled to the collection chamber through a bendable joint. Castaneda teaches an assembly wherein an instrument is connected to a handle by means of a bendable joint in order to

allow the instrument to articulate relative to the handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the combination of Altobelli and Terry with a bendable between the handle and the collection chamber in view of Castaneda in order to allow the collection chamber to articulate relative to the handle.

Regarding claim 91, 96, 113, and 118, the combination of Altobelli, Terry, and Castaneda disclose a device wherein the collection chamber and the elongated handle portion are couple by a bridge of reduced mechanical strength capable of allowing the cutting edge of the blade to be positioned at a range of angles relative to the longitudinal axis of the handle portion. The bendable joint as taught by Castaneda is being interpreted by the examiner as the bridge of reduced mechanical strength.

7. Claims 102 and 122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Altobelli (U.S. Patent 5,683,406) in view of Terry (U.S. Patent 1,121,053) further in view of Wagner (U.S. Patent 6,099,311).

Regarding claims 102 and 122, the combination of Altobelli and Terry disclose the invention as claimed except for the handle portion being connected to the collection chamber through a ball and socket joint. Wagner teaches using a ball and socket joint connector between a handle portion and an instrument portion of a surgical device in order to attach the handle portion to the instrument portion of the device (column 3 lines 39-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the combination of Altobelli and Terry with a ball

and socket connector between the handle portion and the collection chamber in view of Wagner in order to attach the handle portion to the collection chamber.

Allowable Subject Matter

8. Claim 110 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 53, 70, 86, 88, 90-100, 102, and 104-127 have been considered but are moot in view of the new ground(s) of rejection. The examiner has presented new grounds of rejection as discussed above not necessitated by the amendment making this office action non-final.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3733

/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733